REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, claims 1-27 were pending in this application, of which claims 1, 10, and 19 are independent. In the Office Action mailed May 4, 2006, claims 1-27 were rejected under 35 U.S.C. § 103(a). Following this response, claims 1-27 remain pending in this application. Applicants hereby address the Examiner's rejections.

I. Rejection of the Claims Under 35 U.S.C. § 103(a)

The Examiner rejected independent claims 1, 10, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,790,256 to Brown et al. ("Brown") in view of U.S. patent Application Publication No. 2001/0047246 to Fullen et al. ("Fullen"). To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings. MPEP 2143. In considering a reference, the Examiner must consider the references as a whole, including portions of the references that teach away from the claimed invention. MPEP 2141.03; *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Furthermore, if the proposed modification of a prior art reference to meet the claimed invention would change the principle of operation of the prior art invention, then the teachings of the references are not sufficient to form a *prima facie* case of obviousness. MPEP 2143.01; *In re Ratti*, 270 F.2d 810 (CCPA 1959). Similarly, if the proposed modification would render the prior art unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. MPEP 2143.01; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). As set forth

below, Brown cannot be modified by the teachings of Fullen in the manner suggested by the Examiner because (i) Brown teaches away from Applicants' claimed invention; and (ii) modifying Brown as suggested by the Examiner would change the principle of operation of Brown and would render Brown unsuitable for its intended purpose.

A. Brown Teaches Away from Applicants' Claimed Invention

Applicants' independent claims 1, 10, and 19 call for a method, machine, and system, respectively, to analyze an individual's foot while the foot is in stride. Brown cannot be modified by the teachings of Fullen in the manner suggested by the Examiner because Brown teaches away from analyzing a foot during stride. Brown expressly teaches analyzing a foot "in a normal stance." (Brown at 3:4-7). Furthermore, every embodiment disclosed in Brown indicates that an analyzed foot must be at a standstill in order to obtain stable data: "Step 560 indicates that a pressure screen is then displayed until the consumer becomes still and the data becomes stable." (Brown at 12:31-33; *see also* Brown at 16:14-18 and 18:16-20). Brown further emphasizes that the data is not recorded until stability is reached: "Step 910 in FIG. 10 indicates that the IR processor 244 waits for a stable signal and then records the results of each IR_seen 251." (Brown at 15:55-57). Brown's teaching that stable data is not obtained until the consumer becomes "still" clearly teaches away from modifying the invention disclosed in Brown to dynamically analyze an individual's foot during a stride as claimed in Applicants' invention. Because Brown teaches away from Applicants' claimed invention, there is no motivation or suggestion to modify Brown with the teachings of Fullen, and a *prima facie* case of obviousness has not been established. Accordingly, Applicants' respectfully request that the rejection of claims 1-27 be withdrawn.

B. Modifying Brown as the Examiner Suggests would Change Its Principle of Operation and Render Brown Unsuitable for Its Intended Purpose

The modification of Brown proposed by the Examiner would change the principle of operation of the invention disclosed in Brown and would also render the invention of Brown unsuitable for its intended purpose. The intended purpose of the invention of Brown is "to determine, in a normal stance," various properties of a consumer's foot. (Brown at 3:4-8, emphasis added). To achieve this purpose, Brown's principle of operation is to have a consumer stand stationary in foot wells so that stable data can be obtained. (Brown at 12:31-33; *see also* Brown at 16:14-18 and 18:16-20; *see also* Fig. 1). By definition, analyzing a foot during a stride is not analyzing the foot at a standstill. Thus, modifying Brown to measure pressure readings of a foot during stride would destroy Brown's intended purpose of obtaining data on a foot in the normal position. Furthermore, modifying Brown to measure pressure readings of a foot during stride would change Brown's principle of operation of obtaining stable data by taking measurements of a foot at standstill. Because modifying Brown in the manner suggested by the Examiner would change the principal of operation of Brown and would render Brown unsuitable for its intended purpose, Brown cannot be combined with Fullen in the manner suggested by the Examiner. Accordingly, a *prima facie* case of obviousness has not been established and Applicants respectfully request that the rejection of claims 1-27 be withdrawn.

II. Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The claims may include other elements not addressed herein that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 1, 2006

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